

REMARKS

Applicant acknowledges the Office Action mailed on September 20, 2005. Applicant requests reconsideration of the pending application in view of the above amendments and the following remarks.

Claims 140-151, 153-156, 158-164, 167-173, 175-178, 180-192 and 195-211 are pending in the present application. The Examiner objects to claim 140. In addition, the Examiner rejects claims 198-207 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Finally, all pending claims stand rejected under 35 U.S.C. § 103(a) as obvious in view of the teachings of various pieces of prior art. For the reasons set forth in detail below, Applicants believe the pending claims are in condition for allowance.

Objection to Claim 140

The Examiner objects to claim 140, as line 3 of the claim previously read: "a casing having having." With this response, Applicant amends claim 140 in order to delete the second occurrence of the word "having." Accordingly, Applicant requests that the objection to claim 140 be withdrawn.

Claim Rejections Under 35 U.S.C. § 112

The Examiner rejects claims 198-207 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner believes the specification fails to provide support for the claim limitation of "virtually operating elements disappear." Applicant respectfully disagrees.

With reference to Figures 20(a)-(e) and Figures 21(a)-(h) of the present application, a digital book of the present invention is depicted as including virtual operating elements. As depicted in these figures, an on/off toggle allows the virtual operating elements to disappear and reappear from view of the display. Thus,

Applicant believes that these Figures support the claim limitation that the Examiner believes is unsupported by the specification. Thus, Applicants request that the Examiner withdraw this rejection.

Claim Rejections Under 35 U.S.C. § 103

Independent claims 140, 168, 198, 208, 209 and 210 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,893,132 to Huffman et al. and Japanese Patent JP 408137801A to Yusefu. In making the rejection, the Examiner alleges that Huffman discloses an electronic book, or a mobile display means for displaying information, comprising a majority of the limitations set forth in the claim. The Examiner acknowledges that Huffman does not teach a manipulation region located on the back of the casing when the casing is opened.

The Examiner also asserts that Yusefu teaches the positioning of a manipulation region on the back of the casing. Therefore, the Examiner asserts that

it would have been obvious to one skilled in the art at the time the invention was made to have been motivated to incorporate the method of manipulating the multifunction operation of the element using fingers as taught by Yusefu into the system of Huffman because this will provide simplicity and speedy key input to Huffman's device by holding the casing by hand and manipulating the operation element at the same time.

Applicant respectfully disagrees.

Applicant believes the invention set forth in the independent claims is not obvious in view of the teachings of Huffman and Yusefu.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See M.P.E.P. § 2143. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art *also suggests the desirability of the combination* (emphasis added). *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991)." See M.P.E.P. § 2143.01. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." *Id.* "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). *Id.*

Huffman discloses an electronic book, or an electronic reading device. As described in the background of the invention, Huffman explains that "[m]any hand-held electronic reading devices have a user interface in the form one or more external buttons." See Huffman, column 2, lines 34-35. Huffman seems to teach away from the utilization of external buttons, stating: "[h]owever, many hand-held electronic reading devices implement the user interface in a manner which does not provide a simple, intuitive, or efficient method for navigating the textual information or for accessing the features." As Huffman further elaborates, "[t]he lack of simplicity of using current hand-held electronic reading devices along with the lack of comfort in

handling many of these devices result in some people preferring to read paper book rather than using a hand-held electronic reading device." See Huffman, column 2, lines 43-47. Accordingly, it appears that Huffman teaches away from complex hand held devices with external buttons.

In the Detailed Description of a Preferred Embodiment of the invention, Huffman describes the exterior of the disclosed invention as follows:

[t]o better provide the look and feel of a real book, the front cover member 106 and the back cover member 108 have an exterior made of a material used in real book covers. Examples of such a material include, but are not limited to, leather, simulated leather, vinyl, and a woven fabric such as cotton. The exterior can either be permanently affixed to the front cover member 106 and the back cover member 108, or be in the form of a removable jacket.

See Huffman, column 4, lines 45-52. Thus, Huffman clearly does not anticipate the exterior of the book, which would constitute the backside of the book when the book is in the open configuration, as including a manipulation region. Moreover, the teachings of Huffman expound upon the desire that the electronic book disclosed in Huffman have an exterior similar to a paper book. Specifically, Huffman explains:

[I]t is preferred that the first housing member 102 and the second housing member 104 be substantially symmetric so that the front cover member 106, the back cover member 108, and the spine member 110 rest substantially flat on a flat surface in the open position. The substantial symmetry makes the electronic book feel like a real, paper book being opened to one of its middle pages. As a result, the electronic book can be comfortably held and read in a manner consistent with a paper book.

See Huffman, column 4, line 67 - column 5, line 8.

Based upon the above, Huffman clearly teaches away from the inclusion of buttons or manipulating regions in the rear of the housing. This understanding is further buttressed by Huffman describing that "[t]he book-shaped housing includes a receiving slot 134 which physically receives a removable machine-readable storage medium 136." See Huffman, column 5, lines 38-40. As depicted in Figure 1, the slot

134, power receiving port 138 and data receiving port 140 of Huffman are formed in the edge of the electronic book, not in the back cover or the rear of the casing since Huffman desires the rear of the casing to be similar to a paper book.

Applicant reminds the Examiner that the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also **suggests the desirability of the combination** (emphasis added). See *Mills, supra.* Huffman clearly sets forth the undesirability of the combination set forth by the Examiner in making the rejection. The invention disclosed by Huffman is intended to be configured similar to a paper book so that the electronic book may rest substantially flat on a flat surface in the open position. With the invention configured as such, the inclusion of a manipulation region in the rear of the casing is in direct contrast with that which Huffman teaches is a desirable attribute of the invention disclosed therein. Accordingly, Applicant asserts the Examiner cannot combine Huffman and Yusefu as set forth in the Office action, as Huffman actually teaches away from the combination.

Each of the interpreted claims require either a manipulation region located on the back of the casing (see claims 140, 168 and 198) or navigation input means located in the rear of the housing (see claims 208, 209 and 210). Accordingly, Applicant submits that the obviousness rejection set forth by the Examiner in combining the teachings of Huffman and Yusefu is improper. Thus, Applicant submits that independent claims 140, 168, 198, 208, 209 and 210 are allowable over the combination of prior art set forth by the Examiner. Moreover, as all pending dependent claims each ultimately depend from one of the independent claims, Applicant asserts that all pending claims are allowable over the cited combination.

Conclusion

For the reasons set forth above, Applicant believes the pending claims are allowable over the cited prior art. In addition, with the amendments made above,

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Amdt. Dated March 20, 2006

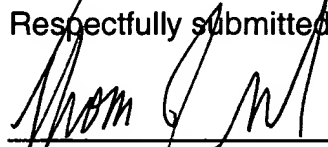
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Applicant believes the objection to claim 140 should be withdrawn. Moreover, Applicant believe the specification provides adequate support for claims 198-207 and thus, requests the rejection of these claims under 35 U.S.C. § 112 be withdrawn. Accordingly, Applicant believes the pending application is in condition for allowance and respectfully requests passage thereof.

If necessary to affect a timely response, please consider this paper a request for an extension of time, and charge any shortages in fees, or apply any overpayment credits, to Baker & Daniels' Deposit Account No. 02-0387 (72262.90033). However, please do not include the payment of issue fees.

Respectfully submitted,

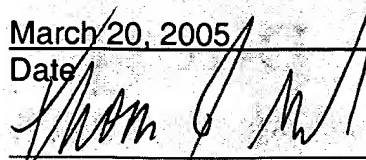


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March 20, 2005

Date



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